

REMARKS

This Amendment is responsive to the Office Action dated March 28, 2006. Applicant has amended claims 35-37 to correct typographical errors introduced in the previous Amendment. Claims 1, 2, 4-19, 21-40 and 42 remain pending.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42

In the Office Action, the Examiner rejected claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42 under 35 U.S.C. § 103(a) as being unpatentable over US 6,049,821 to Theriault et al. (Theriault), in view of US 6,728,785 to Jungck (Jungck), and in further view of US 6,327,392 to Li (Li).

Applicant respectfully traverses these rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

With reference to independent claims 1, 19 and 33, for example, the applied references lack any teaching that would have suggested transmitting or sending original web page source data including characters of identified non-renderable character data that were removed to a remote client after transmitting or sending modified web page source data in which the characters were removed to the remote client.

The Examiner acknowledged that Theriault and Jungck fail to disclose or suggest this requirement of claims 1, 19 and 33. However, the Examiner argued that it would have been obvious to one of ordinary skill in the art "to modify Theriault by transmitting a modified page to a client, and transmitting the original page to the client in response to another request from the client for the original page," in view of the teachings within Li. Applicant respectfully disagrees with this conclusion.

As recognized by the Examiner, Li teaches allowing a user to observe a low-resolution, low-quality version of an image prior to deciding to request a full-resolution, high quality version of the image.¹ Modification of an image, as taught by Li, is completely unrelated to removal of

¹ Office Action, page 6; Li, col. 4, ll. 33-36.

characters, as recited in Applicant's independent claims. Contrary to the Examiner's argument, transmitting an unmodified image in response to a user request would have in no way suggested transmitting or sending original web page source data including non-renderable characters that were removed.

Because Li is entirely focused on images, a person of ordinary skill in the art would have only looked to Li for teachings related to images. Accordingly, a person of ordinary skill in the art would not have looked to Li for modification of the way in which the Theriault proxy handled character data. In other words, if Li would have suggested *any* modification of the Theriault proxy, Li would have suggested modification of the manner in which the proxy handled images.²

However, a person of ordinary skill would not have considered any other modification of the Theriault proxy, much less modification such that the proxy would transmit or send original web page source data including characters of identified non-renderable character data that were removed after transmitting or sending modified web page source data in which the characters were removed, as required by independent claims 1, 19 and 33. Accordingly, the combination of Theriault, Jungck, and Li would not have rendered this requirement of the independent claims obvious to a person of ordinary skill in the art.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Applicant's claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42 under 35 U.S.C. § 103(a). Withdrawal of these rejections is respectfully requested.

² Theriault, col. 15, ln. 66 col. 16, ln. 5, col. 17, ll. 39-50, col. 18, ln. 44 col. 19, ln. 56.

Claims 2, 5, 11, 12, 14, 15, 21, 22, 25, 26, 28, 29, 34, 36-39

In the Office Action, the Examiner rejected claims 2, 5 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Theriault in view of Jungck and Li, and in further view of US 6,311,223 to Bodin et al. (Bodin); claims 11 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Theriault in view of Jungck and Li, and in further view of US 6,424,981 to Isaac et al. (Isaac); claims 12, 26, 34 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Theriault in view of Jungck and Li, and in further view of US 6,615,266 Hoffman et al. (Hoffman); claims 14, 15, 28, 29, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Theriault in view of Jungck and Li, and in further view of US 6,546,388 to Edlund et al. (Edlund); and claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Theriault in view of Jungck and Li, and in further view of US 6,557,005 to Burget (Burget).

Applicant respectfully traverses these rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

As an initial matter, Applicant notes that none of Bodin, Isaac, Hoffman, Edlund, or Burget provides any teaching that would have overcome the deficiencies of Theriault, Jungck and Li with respect to the requirements of the independent claims discussed above. Further, Bodin, Isaac, Hoffman, Edlund, or Burget fail to disclose or suggest a number of the requirements of the claims against which they are applied.

For example, the applied references fail to disclose or suggest a method comprising identifying tags of web page source data having one or more uppercase characters, and rewriting the identified tags of the web page source data to have the same characters but in lowercase, as required by claim 2, as well as the similar requirement of claim 39. In the previous submission, Applicant amended claims 2 and 39 to clarify that they require the same characters, but in lowercase. The Examiner relied on Bodin for this requirement of claims 2 and 39.

However, Bodin fails to disclose or suggest rewriting tags to have the same characters, but in lower case. Instead, Bodin teaches "tokenizing" tags. Tokenizing tags, as taught by Bodin, involves removing letters from the tags, contrary to the requirements of claims 2 and 39.³

³ Bodin, col. 6, ll. 1-20 (LOOKUP TABLE).

Accordingly, Bodin would not have suggested modification of the Theriault proxy to identify tags of web page source data having one or more uppercase characters, and rewrite the identified tags of the web page source data to have the same characters but in lowercase, as required by claims 2 and 39.

As other examples, the applied references fail to disclose or suggest removing data in the ASCII format, as required by claims 11 and 25, removing hard returns, as required by claim 36, or removing keywords configured to be interpreted by a search engine, as required by claims 15, 29 and 38. The Examiner acknowledged that Theriault fails to disclose or suggest these requirements of Applicant's claims. Moreover, Isaac, Hoffman and Edlund fail to disclose or suggest removing data in the ASCII format, hard returns, or keywords.

The Examiner did not assert that Isaac, Hoffman and Edlund disclose or suggest these requirements of Applicant's claims. Instead, the Examiner's position appears to be that, merely because data in the ASCII format, hard returns, and keywords are known to be part of web page source data, it would have been *per se* obvious to remove them. This conclusion is contrary to clear Federal Circuit precedent.

It is well established that the Examiner bears the burden of establishing a *prima facie* case of obviousness.⁴ In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention.⁵ This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.⁶ A *prima facie* case of obviousness is established only when this burden is met.

In the present case, the Examiner has cited no teaching or suggestion in the prior art of removing data in the ASCII format, hard returns, or keywords, as required by Applicant's claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for claims 11, 15, 25, 29, 36 and 38.

⁴ *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

⁵ *In re Chu*. 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

⁶ *Id.*

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Applicant's claims 2, 5, 11, 12, 14, 15, 21, 22, 25, 26, 28, 29, 34, 36-39 under 35 U.S.C. § 103(a). Withdrawal of these rejections is requested.

Rejection for Obviousness-type Double Patenting:

The Examiner rejected claims 1, 2, 4-19, 21-40, 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-82 of U.S. Patent No. 6,834,297. A Terminal Disclaimer accompanies this Amendment. The disclaimer is made to expedite issuance and is not intended as an admission that any claim of the present application is the same or an obvious variant of those of U.S. Patent No. 6,834,297. This disclaimer obviates the double patenting rejection of claims 1, 2, 4-19, 21-40, 42 as being unpatentable over U.S. Patent No. 6,834,297.

The Examiner also provisionally rejected claims 1 and 5-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/968,555. Applicant respectfully traverses this rejection. Independent claim 1, from which claims 5-7 depend, recites numerous limitations that are not found in, and would not have been obvious in view of, claims 1-6 of copending Application No. 10/968,555.

For example, independent claim 1 recites identifying within the original web page source data renderable character data and non-renderable character data, the renderable character data being data that affects the presentation of the web page by a browser, and the non-renderable character data being data that does not affect the presentation of the web page by a browser, filtering at least a portion of the non-renderable character data by removing characters of the identified non-renderable character data from the original web page source data, thereby creating modified web page source data, and transmitting the original web page source data to the remote client including the characters that were removed after transmitting the modified web page source data to the remote client. These limitations are not recited in or obvious over claims 1-6 of copending Application No. 10/968,555. Accordingly, Applicant respectfully requests that the rejection of claims 1 and 5-7 as being unpatentable over copending Application No. 10/968,555 be withdrawn.

CONCLUSION

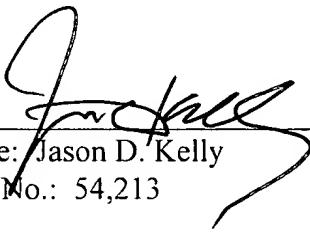
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

6/28/06

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